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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,035	01/23/2004	Eddie Chen	B-5329 621563-7	7965

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EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/764,035

**Applicant(s)**

CHEN, EDDIE

**Examiner**

Anthony Stashick

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7 and 12 are rejected under 35 U.S.C. 102(B) as being anticipated by Lyness

2,340,603. Lyness '603 discloses all the limitations of the claims including the following: an outsole (see Figure 2); an upper 4 connected to said outsole; said upper having an inner surface (inside shoe wall), an outer surface (outer shoe wall), and at least one first ventilating opening 14 extending through said inner and outer surfaces; a flexible protection sheet 16 disposed over said first ventilating opening and fixed to said upper (by stitches 18); a second ventilating opening (another of 14) which is defined at least by said protection sheet (located under the sheet) and which is staggered with respect to said first ventilating opening (to the left or right of the first chosen opening); said second ventilating opening being cooperative with said first ventilating opening to ventilate the shoe (both allow air into and out of the shoe); a fastening unit 18 to fix said protection sheet to said upper; said protection sheet has a marginal end (that along the outer edge of the sheet) and an interior part (that located inward of the outer edge) surrounded by said marginal end; said fastening unit being attached solely to said marginal end (see Figure 1) so that said interior part is movable relative to said upper; said protection sheet covers entirely said first ventilating opening (see Figures); said fastening unit being attached to a portion of said marginal end so that said marginal end has another portion (portion furthest away from the toe near foot opening) which is movable relative to said upper; said second ventilating opening (another of 14) being defined between said another portion of said marginal end and said outer surface of said upper (see Figure 1); said protection sheet is polygonal (has multiple sides) and has a plurality of sides (see Figure 1) which define

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said marginal end; said sides including two first sides (lateral and medial) which are substantially opposite to each other, and second sides (toe and tongue) connected to said first sides; said fastening unit (stitches 18) being attached to said first sides; said second ventilating opening being defined between each of said second sides and said outer surface of said upper (see Figure 1); said fastening unit includes stitches 18 which fasten said protection sheet to said upper; said upper includes a plurality of said first ventilating openings 14; said second ventilating opening is formed in said interior part of said protection sheet (see Figure 1, inside the outer edge of 16) at a position which is staggered with respect to said first ventilating opening (see Figure 1).

3. Claims 1-4, 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu 5,551,172. Yu '172 discloses all the limitations of the claims including the following: an outsole 16; an upper 14 connected to said outsole; said upper having an inner surface (inside of shoe upper), an outer surface (outside shoe upper), and at least one first ventilating opening 56 extending through said inner and outer surfaces; a flexible protection sheet 60 disposed over said first ventilating opening (hole in mesh 58) and fixed to said upper (see Figure 7); a second ventilating opening (another hole in the mesh 58) which is defined at least by said protection sheet (located between protection sheet and inside of shoe) and which is staggered with respect to said first ventilating opening (mesh holes staggered diagonally); said second ventilating opening being cooperative with said first ventilating opening to ventilate the shoe (ventilation holes 14 ventilate shoe); a fastening unit 62 to fix said protection sheet to said upper; said protection sheet has a marginal end (exterior border) and an interior part (inside exterior border) surrounded by said marginal end; said fastening unit being attached solely to said marginal end (see Figures 7 and 8) so that said interior part is movable relative to said upper; said protection sheet covers entirely said first ventilating opening (see Figure 7); said fastening unit being attached to a portion of said marginal end so that said marginal end has another portion which is movable relative to said upper (see Figure 8); said second ventilating opening being defined between said another portion of said marginal

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end and said outer surface of said upper (see Figures 7-8); said protection sheet is polygonal (has multiple sides) and has a plurality of sides which define said marginal end; said sides including two first sides (lateral and medial) which are substantially opposite to each other, and second sides (toe and tongue) connected to said first sides; said fastening unit being attached to said first sides (see Figures 7-8); said second ventilating opening being defined between each of said second sides and said outer surface of said upper (see Figures 7-8); said upper includes a plurality of said first ventilating openings (holes in mesh); said fastening unit includes hook-and-loop fasteners (see col. 4, lines 2-6); said fastening unit includes a plurality of studs 62.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lyness 2,340,603 as applied to claim 1 above. Lyness '603 discloses all the limitations of the claims except for the fastening unit including an adhesive which cements the protection sheet to the upper. Since the protection sheet of Lyness is made to cover the opening and be secure to the upper, the use of cement or any other art accepted fastening means to fasten the cover to the upper would have been well within the skill of one of ordinary skill in the art. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to cement the edges of the cover to the upper to help in holding the cover over the opening to prevent debris from entering the shoe through the opening in the upper.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of the references as applied to claim 1 above in view of DeKalb et al. 6,408,540. Each of the references as applied to claim

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1 above discloses all the limitations substantially as claimed except for the first ventilating opening being a slit. DeKalb et al. '540 teaches that a slit 41 (see Figure 1) located in the heel of a boot can allow for water to drain out of the boot when necessary. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the openings in the boot of either of the references as applied to claim 1 above, slits, to allow for them to open and close with the use of the boot to aid in preventing material from accidentally entering the boot.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of the references as applied to claim 1 above in view of Mazzarolo 4,693,021. Each of the references as applied to claim 1 above discloses all the limitations substantially as claimed except for the upper being formed of a plurality of sheet parts which are assembled together, said first ventilating opening being defined by more than one of said sheet parts which are adjacent to each other, said more than one of said sheet parts having respective edges which are indented to cooperatively define said first ventilating opening. Mazzarolo '021 teaches that the upper portion of a boot can be formed of a plurality of sheets 2, 26, 27 which are assembled together and have first ventilating openings 14 29, 20 defined by more than one of the sheet parts that is adjacent to one another, the respective edges of the sheets are indented to cooperatively define the first ventilating openings (see Figure 2). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper of the shoes of each of the references as applied to claim 1 above, out of multiple layers with the openings in the layers, the openings having indented edges, to allow for the entire boot to ventilate from inside the boot outwardly and dissipate perspiration of the user's foot.

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the references as applied to claim 1 above, in view of Ohashi 4,771,555. Either of the references as applied to claim 1 above discloses all the limitations substantially as claimed except for an air permeable sheet covering the first ventilating opening and being disposed inwardly of the protection sheet, being located

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between the protection sheet and the upper, and provided with screen openings. Ohashi '555 teaches that an air permeable sheet 16 can be located over the first ventilating openings 11 to prevent ingress of water while the protection sheet protects the air permeable member from being accidentally torn. The air permeable member is provided with screen openings (the openings in the air permeable member which allows air to flow through it) to allow for the ingress and exit of air within the shoe. Therefore, it would have been obvious to place an air permeable member between the protective cover and the first ventilating openings in the shoe to aid in filtering out the larger particles while still allowing air to enter and exit the shoe and prevent water from entering the shoe.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is written in a cursive, flowing style with some loops and flourishes.

Anthony Stashick  
Primary Examiner  
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ADS